



D-1077+18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Jay Drummond, et al.)	
)	
Application No.: 09/639,310)	Art Unit 3691
)	
Appeal No.: 2007-4204)	
)	
Confirmation No.: 9530)	Patent Examiner
)	Olabode Akintola
Filed: August 14, 2000)	
)	
Title: Automated Banking Machine)	
Customer Profile Method)	

Mail Stop ISSUE FEE
 Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

Sir:

In response to the Notice of Allowability of October 14, 2011 please enter Applicants' "Comments on the Statement of Reasons for Allowance" without prejudice. These Comments also include remarks which clarify the record.

COMMENTS ON THE STATEMENT OF REASONS FOR ALLOWANCE

(1) Any Office remarks which attempt to narrow the claims should be disregarded

Applicants acknowledge the Office's admission that all pending claims are patentable over the prior art, and that there is no teaching, suggestion, motivation, or valid reason for one of ordinary skill in the art to have produced the recited invention.

Applicants respectfully submit that while the specific claim features and relationships mentioned by the Office in the record (which infer the reasons for allowance) are not disclosed or suggested in the prior art, these are not the only recited features and relationships which are not found or suggested in the prior art. Furthermore, the record sometimes indicates a general paraphrasing of claim language, and not necessarily the exact or complete claim language. The record also refers to subject matter or language which is not recited (or required to be performed) in all of the claims. Thus, not all claims require the features, relationships, or language mentioned by the Office in the record. It should be understood that the claims are to only be limited by that subject matter which is positively recited. Any remarks in the record by the Office which attempt to narrow the recited subject matter should be disregarded.

(2) The Office improperly reintroduced a same rejection reversed by the BPAI

The rejection of claim 17 was legally improper. The Board of Patent Appeals and Interferences (BPAI) in their decision mailed 4/18/2008 reversed this same rejection of claim 17.

Facts of record

The following dates and papers are associated with this application:

1. 4/18/2008 BPAI decision. The BPAI (at decision page 26) reversed the 35 U.S.C. § 103(a) rejection of claim 17 based on Wagner (U.S. 5,742,845) in view of Dasan (U.S. 5,761,662), Lawlor (US 5,220,501), Simmons (US

5,974,451), and Patterson (US 5,915,246).

2. 4/6/2011 Office Action. Non amended claim 17 was again rejected (at Action page 5) under 35 U.S.C. § 103(a) based on the *same* references to Wagner, Dasan, Lawlor, Simmons, and Patterson. That is, claim 17 received the identical rejection which the BPAI already fully considered and reversed.
3. 7/5/2011 Request for reconsideration of the claim 17 rejection. Claim 17 was not amended. Applicants pointed out that the Examiner was legally barred from reintroducing the identical rejection of claim 17.
4. 7/29/2011 Final Office Action. Examiner failed to withdraw the rejection of claim 17.

The record shows that the final 35 U.S.C. § 103(a) rejection of claim 17 was identical to a previously appealed rejection which was already fully considered by the BPAI in Appeal No. 2007-4204. In their decision mailed 4/18/2008, the BPAI reversed said rejection of claim 17. Thus, the Examiner was legally barred from again asserting this same rejection based on principles of *res judicata*. The Examiner was also committing prejudicial error.

37 C.F.R. § 1.198 indicates that prosecution following a BPAI decision can be reopened or reconsidered "only for the consideration of matters *not* already adjudicated." Thus, the reintroduction of the identical claim 17 rejection was further legally improper.

Nor can prosecution be based on a double jeopardy rejection. The Office cannot force Applicants to appeal twice on the same issue. The Office has no authority to continually reintroduce a rejection which was reversed by the BPAI, otherwise prosecution length would be arbitrary and capricious, if not endless. If reintroduction of a reversed rejection is permitted then the appeal process would be rendered meaningless. The rejection of claim 17 was legally improper and should have been withdrawn.

(3) The final rejection was premature

The final rejection dated 7/29/2011 should have been withdrawn because it was premature and legally improper. Applicants were not given fair opportunity in any accordance with 37 C.F.R. 1.111 to properly rebut the Office's newly imposed ground of rejection. The Office committed prejudicial error by depriving Applicants of their administrative due process rights (e.g., timely notice of the Examiner's position and opportunity for unhindered response thereto). As explained in more detail hereafter, the record shows that the conditions did not meet the legal criteria for the Office to impose a final rejection on 7/29/2011.

The applicable legal standards

MPEP § 706.07(a) states:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

The facts of record

The following dates and papers are associated with this application:

1. 4/6/2011 Non final Office Action. Claim 7 was rejected under 35 U.S.C. § 103(a) based on Wagner (U.S. 5,742,845) in view of Dasan (U.S. 5,761,662), Lawlor (US 5,220,501), and Simmons (US 5,974,451).
2. 7/5/2011 Request for reconsideration of the claim 7 rejection. Claim 7 was not amended.
3. 7/29/2011 Final Office Action. Claim 7 was rejected based on Wagner in view of Dasan, Lawlor, Simmons, and *Patterson* (US 5,915,246).

That is, the Examiner applied a new rejection to non amended claim 7, and then made this new rejection final. As can be seen, this new ground of rejection included the newly applied Patterson reference.

Review of the facts of record

The facts of record showed that:

- (1) The final Office action of 7/29/2011 introduced a new ground of rejection to claim 7;
- (2) The new ground of rejection was *not* necessitated by an amendment; and
- (3) The new ground of rejection was *not* necessitated by an IDS.

Legal result of the facts of record


The facts showed that the finality of the Office action dated 7/29/2011 was premature.

Conclusion

Applicants have continually reserved all rights to refile canceled subject matter, especially in light of the above-noted legally improper (and highly unreasonable) rejections of claims 7 and 17. Applicants have not waived any right to obtain similar claim coverage through a different US application, with similar subject matter considered by a different (and more reasonable) examiner, including an examiner in a different Art Unit or Technology Center.

Respectfully submitted,

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